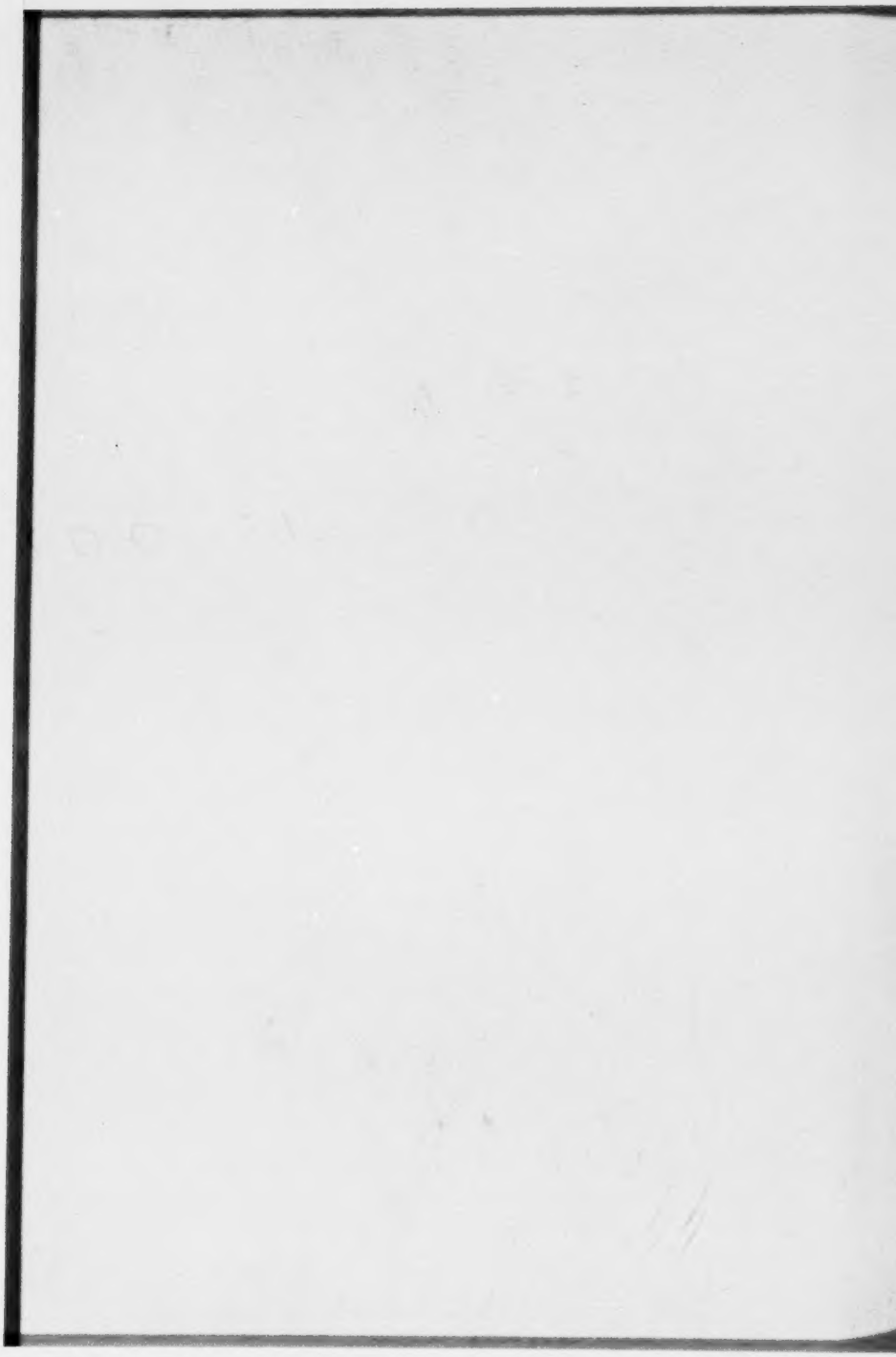

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Supreme Court of the United States

OCTOBER TERM

No. 928

CUTLER MAIL CHUTE COMPANY,

Petitioner, Plaintiff
and Appellee below

—against—

CAPITOL MAIL CHUTE CORPORATION,

Respondent, Defendant
and Appellant below.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

ROBERT I. DENNISON,
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PERCY FREEMAN,
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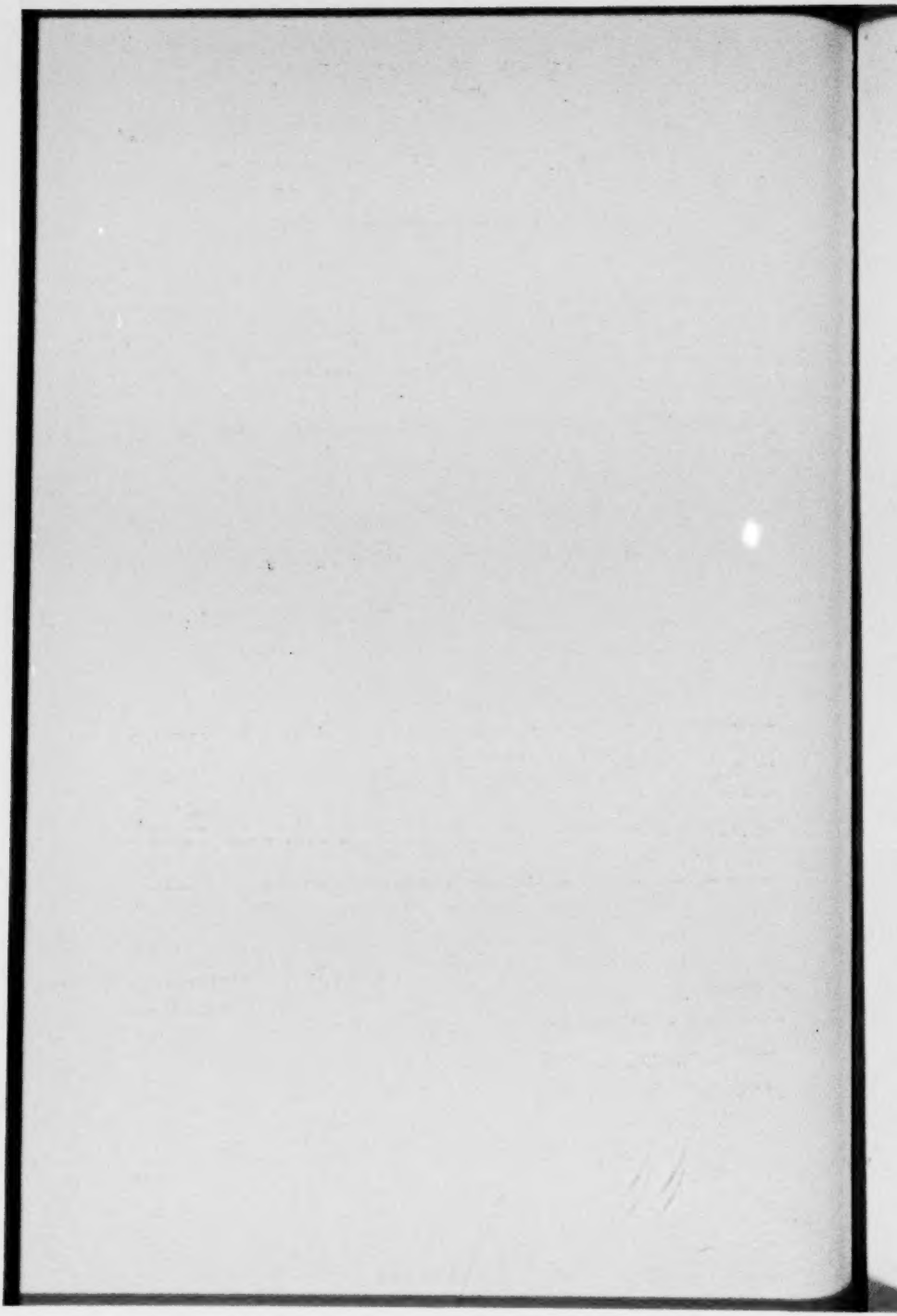

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

Statement.

This brief is directed in reply to petitioner's brief in support of its petition for writ of certiorari.

In its "Summary Statement of the Matter Involved", petitioner states that no motion to amend the Findings of Fact, or to make additional Findings, was made by the Defendant (Respondent here). Rule 52(b) of the Rules of Civil Procedure states in part as follows:

> "When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question

has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment."

In arriving at its decision the Court of Appeals must have held that those Findings of Fact and Conclusion of Law and the decision upon which the decree was founded, were "clearly erroneous", otherwise the Court of Appeals would not have reversed the decree.

In Answer to Petitioner's Contention in Support of Jurisdiction.

Petitioner, in urging that this Court has jurisdiction to review the judgment in question, presents three points, namely, (I) that there were no concurrent findings by the courts below; (II) that there is no possibility of obtaining a conflicting decision in a Court of another appellate jurisdiction; (III) that there is jurisdiction by this Court under Section 240a of the Judicial Code (p. 2 of Pet. and Br.).

In support of point (I) (p. 5 of Pet. and Br.) petitioner contends that since the District Court had considered all of the claims of the patent in suit, the Circuit Court of Appeals should have done likewise. Respondent submits that the Court of Appeals was correct in considering claim 2 only of the patent in suit because this combination claim brings out and includes all of the essential elements of the alleged invention and consequently if this claim falls the other claims, must *ipso facto* fall, the other claims being mere variations of this claim or broader than this claim. The other claims do not embrace a different structure. In claim 8, given as an example by the Petitioner, the *device arranged between the two apertures adapted to block access* of usual mail matter inserted through the upper receiving aperture from passage to the lower discharge aperture while permitting passage of small objects, such as. litter simi-

larly introduced to and through the discharge aperture" is expressed and finds its equivalent in claim 2 in *a weighing device* operating in the passage to normally direct light foreign matter deposited in the mailing aperture to the delivery aperture but adapted to be displaced by mail matter and permit its passage to the chute."

Therefore, Petitioner's statement that there were no concurrent Findings by the Courts below as to the claims in issue, is erroneous.

Petitioner relies upon the case of *Altoona Pub. Theatres* v. *Am. Tri-Ergon Corp.*, 294 U. S. 477. In that case this Court stated:

> "The Court of Appeals in upholding the patent, made no examination of its separate claims, but treated the patent as though it were a combination of five distinct elements, the photo-electric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel and the optical slit, *although nowhere in the patent is any such combination claimed.* The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the claims of the patent which define the invention."

That is what led this Court to the conclusion that:

> "While both courts below have found invention and sustained the patent, the Court of Appeals as will presently appear in more detail, did not pass on the separate claims in issue, but found invention in a combination of elements not embraced in any single claim. In consequence, the case presents no question of concurrent findings by the courts below that the claims in issue severally involve invention."

If there were invention in the case at bar, it would be found in a combination of elements embraced in any single claim.

It might be mentioned here in passing, that this Court in the *Altoona* v. *Am. Tri-Ergon* case stated that:

> "An improvement to an apparatus or method to be patentable, must be the result of invention, and not the mere exercise of the skill of the calling or an advance plainly indicated by the prior art. *Electric Cable Joint Co.* v. *Brooklyn Edison Co.*, 292 U. S. 69, 79, 80."

The Circuit Court of Appeals followed this Court in ruling that

> "Since Van Riper is chargeable with knowledge of everything disclosed by the Teevan patent and the latter shows the concept of segregating letters from trash that might be put into the receiving aperture of a mail collecting receptacle, Van Riper's claim to invention must rest upon the mechanical changes which would be required to adapt the Teevan structure for use in a mail chute. Obviously Teevan's chute would have to be compressed and turned from a nearly horizontal position to one nearly vertical. It is urged that if that were done the trash would gather at the bottom of the chute against the flap C; and so it would if the edge of the flap rested on a bottom bar of the chute and enough below the last slot of the grid to form a shelf upon which the trash could rest. But the merest tyro should be able to see that the more nearly vertical the chute, the more open it could and should be. Teevan had the bars of his grid rather close together because it was nearly horizontal and the letters must be as sure to pass over the openings as the trash must be to drop through them. To space more widely apart the two lowest bars of the grid and to slant the hinged flap C so that it would divert the trash into the opening rather than serve as a shelf upon which it could gather, were adaptations that would shriek to be made to one who

was trying to solve Van Riper's problem with Teevan's structure before him. *We are of opinion that the appellant is right in urging that nothing but ordinary mechanical skill was required to convert Teevan's device into that of the patent in suit.*

With respect to Petitioner's point (II) (p. 7 of Pet. and Br.) in support of jurisdiction, the competitive field in the art to which the patent in suit pertains is indeed very narrow, there being relatively few manufacturers of mail chutes. Consequently, any lack of copying of the patented structure, is due to the scarcity of competitors rather than respect for the patent. Indeed, the Petitioner may have answered the cause for the so-called respect for the patent by its own statement, namely:

> "The present economic conditions have suspended or limited the requirement of mail chutes with this patented device therein. In consequence, as no one else is making or selling in another judicial circuit a structure such as to be an infringement * * * " (pp. 7, 8 of Pet.).

The mail chute business is not concentrated in the second circuit, hence Petitioner is not in the same position as the plaintiff in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 49.

With regard to petitioner's point (III) (p. 8 of Pet. and Br.), subdivision 5 of Rule 38 of the Rules of this Court specifically sets out the Grounds for Granting Review by Certiorari.

> "A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor."

There is no situation in the case at bar which falls within the character of reasons which ought to be considered by this court. There is no conflict of decisions between two circuit court of appeals; there is no important question of general law in a way probably untenable or in conflict with the weight of authority or a federal question in conflict with applicable decisions of this court which was decided by the Circuit Court of Appeals, but only questions which are well founded in patent law.

The power of The Supreme Court to send a writ of certiorari to the Circuit Court of Appeals is exercised by it only in cases of great importance; or in cases of conflict between two or more Circuit Court of Appeals, or between such a court and a state court; or in cases which effect some interest of this nature. (*Forsyth* v. *Hammond,* 166 U. S. 506, 514, 41 L. Ed. 1095). And it is only when the lower courts are distinctly wrong that they will be reversed on questions of fact. (*Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 52 L. Ed. 1122). *See Walker on Patents, Deller's Edition* (1937) Vol. 3, pp. 1945, 1946.

Regarding Petitioner's Reasons for Granting Writ (pp. 3, 4 of Pet. & Br.)

In Answer to Petitioner's Argument Appearing Under 1, on Page 9 of its Petition and Brief.

Petitioner states that the findings of fact should have been considered as unassailable under R. C. P. 52. The primary purpose of rule 52 of the Rules of Civil Procedure that in all actions tried upon facts without a jury, the court shall find the facts specially and state separately its conclusions of law thereon is intended to aid the reviewing court by affording a clear understanding of the basis of the decision of the trial court. *Tulsa City Lines* v. *Mains,* C.

C. A. Okl. 1939, 107 F. 2d 377. The findings of fact of the District Court in the case at bar did serve such purpose for the Circuit Court of Appeals, but the latter court saw fit to reverse the findings of the lower court, as by its decision it deemed the same clearly erroneous. In *Malloy* v. *New York Life Insurance Co.,* 103 F. (2) 439 (C. C. A. 1) cited by Petitioner, the court stated that "reviewing court is not bound by the trial judge's Findings of Fact." In that case the Court stated that where the credibility of witnesses was a determinative factor in arriving at findings of fact, the reviewing court will not usually upset those findings in view of the opportunity of the trial judge to see and hear witness testify. In the case at bar the prior art was sufficient to invalidate the claims of the patent and a reference to the opinion of the Circuit Court of Appeals will clearly show that that court based its decision of reversal on its construction of the documentary prior art.

The Circuit Court of Appeals is not required to take facts as found by the district judge, but must determine legal effect of facts as presented by the record, on appeal from the judgment. *U. S.* v. *South Georgia Ry. Co.,* C. C. A. Ga. 1939, 107 F. 2d 3; *U. S.* v. *Mitchell,* C. C. A. Mo. 1939, 104 F. 2d 343; *Cherry-Burrell Co.* v. *Thatcher,* C. C. A. Mont. 1939, 107 F. 2d 65.

Petitioner contends that the Circuit Court of Appeals did not refer to "pertinent Findings of Fact of the District Court as to the Teevan Patent" set out on page 9 of its Petition and Brief. Petitioner is clearly in error in its contention. The Circuit Court of Appeals in its opinion (R., p. 278; F. 833) in referring to defendant's (respondent's) contention that plaintiff's (petitioner's) idea of an apparatus which accepts mail and rejects refuse is old in the art, stated:

> "But its chief reliance is on the Teevan patent. This is a patent for a "letter box", which is analagous art

> and is classified by the Patent Office in the same class as mail chutes, namely, class 232 'Deposit and Collection Receptacles.' 'The patent states that the invention relates to improvements in letter boxes and is designed 'to prevent the contents being injured by the introduction of lighted matches, burning cigars or cigarettes, and such like.' Thus the conception of separating mail from trash and preventing the latter from getting into the collection receptacle long antedated the patent in suit and the means adopted by Teevan to accomplish this purpose are strikingly similar to those adopted by Van Riper more than 30 years later."

The court then goes at length into the construction of the Teevan patent and its application to the alleged invention of the patent in suit. In the face of the opinion of the Circuit Court of Appeals, how in the name of common sense, can the petitioner contend that the Circuit Court of Appeals did not refer to the pertinent Findings of Fact of the District Court as to the Teevan patent. A comparison of the facts set out in the opinion of the Circuit Court of Appeals with the Findings of Fact of the District Court is convincing that the latter were shown to be "clearly erroneous" and the Circuit Court of Appeals was correct in not accepting these as premises.

In Answer to Petitioner's Argument Appearing Under 2, on Page 11 of its Petition and Brief.

Petitioner argues that the Circuit Court of Appeals used *ex post facto* wisdom from the patent in suit to reconstruct a prior structure; that the Appellate Court reconstructed the Teevan patent in the light of the teachings of the patent in suit. Nothing is further from the truth. The Circuit Court of Appeals considered the prior art *as it is* and applied it to the patent in suit in the light of the knowledge chargeable to Van Riper, the patentee and of ordinary mechanical skill required for conversion.

"Since Van Riper is chargeable with knowledge of everything disclosed by the Teevan patent and the latter shows the concept of segregating letters from trash that might be put into the receiving aperture of a mail chute collecting receptacle, Van Riper's claim to invention must rest upon the mechanical changes which would be required to adapt the Teevan structure for use in a mail chute." (R., p. 279; F. 835.)

"We are of opinion that the appellant is right in urging that nothing but ordinary mechanical skill was required to convert Teevan's device into that of the patent in suit." (R., p. 279; F. 837.)

Answering Petitioner's Argument Appearing Under 3, on Page 12 of its Petition and Brief.

The combination of old mechanical parts in the patent in suit did not produce any new result. Petitioner's combination in its entirety is found as an entirety in the prior art. The Circuit Court of Appeals in no mistakeable terms so decided. That Appellate Court without doubt did disturb the subject matter (in the Findings of Fact) set out at pages 12 and 13 of Petitioner's Brief. That the combinations in the patent in suit and in the Teevan Patent are *not* patentably different; that they do not function differently; that the combinations of the patent in suit do *not* produce a new and useful result over the Teevan patent structure; and that the law of structure of the Teevan patent does *not* present a coaction of parts totally different from the cooperative law of the patent in suit, may be gleaned from the upper courts decision. Thus, the upper court ruled that the subject matter in the lower court's findings is "clearly erroneous".

Petitioner opines that a combination claim is valid unless anticipated by the same entirety or combination and that this rule requires a comparison of the claims of the patent

in suit with the alleged prior art in regards to the so-called cooperative law or entirety set into being by the patented combination. The Circuit Court of Appeals in its opinion made the comparison. In referring to the Teevan structure it stated:

> "Within the letter-box is a chute A having its upper open end coinciding with the letter-slot. At the other end of the chute is hinged a weighted flap C so balanced that a descending letter will cause it to open and allow the letter to fall into the box. The bottom side D of the chute is provided with a number of slots of sufficient width to allow matches, cigarettes and such like to drop through this grid into a receptacle E fixed beneath the chute."

The Circuit Court of Appeals properly held that the Teevan patent did anticipate the patent in suit and that it did present the same entirety. There is no conflict between the holding by the Circuit Court of Appeals and the law of this Court, for the Appeals Court found the combination claim anticipated by the Teevan patent which shows the same entirety or combination as the patent in suit and only requires the application of ordinary mechanical skill for the slight change-over.

There is no conflict in the courts as to the subject matter presented by petitioner for consideration by this court. The patentee of the patent in suit neither invented a combination of elements which produced a new result nor produced an old result "in a more facile, economical and efficient manner". The Court of Appeals for the Second Circuit so decided and reversed the decree of the District Court.

Borrowing from petitioner's brief (p. 15) the citation *Iron Fireman Mfg. Co.* v. *Industrial Engineering Corp.*, 89 F. (2d) 90 (C. C. A. 7) and restating the exact excerpt taken therefrom by petitioner.

"We do not regard this holding as inconsistent with that of *Hartman F. & C. Co.* v. *Barring,** for in that case there was *neither a new result nor an old one performed more efficiently.*"

This court has repeatedly held a patent invalid because the combination of elements neither produced a new result nor produced an old result in such a way as to rise to the dignity of invention. *Wright* v. *Yuengling,* 155 U. S. 47, 53; *Stimpson* v. *Woodman,* 10 Wall. 117; *Smith* v. *Nichols,* 21 Wall. 112; *Guidet* v. *Brooklyn,* 105 U. S. 550; *Hall* v. *Macneale,* 107 U. S. 90.

Petitioner asks this Court to grant the writ because it contends that there is a sharp conflict as to the law of combinations. This was not involved in the decision of the Circuit Court of Appeals. That Appellate Court ruled that the patentee is chargeable with knowledge of everything disclosed by the Teevan patent; that the latter shows the concept of segregating letters from trash that might be put into the receiving aperture of the mail collecting receptacle; and that nothing but ordinary mechanical skill was required to convert Teevan's device into that of the patent in suit. The Appellate Court followed the decision of this Court in *Samac Automatic Machine Corp.* v. *Wirebounds Patents Company et al.,* 282 U. S. 704, where at page 713, Mr. Justice Stone stated for the Court:

"Their adaptation to the new use was not the creative work of the inventive faculty. It was "but the display of the expected skill of the calling, and involves only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice." *Hollister* v. *Benedict*

* (C. C. A. 7) 59 F. (2) 29).

Mfg. Co., 113 U. S. 59, 72, 73; *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177; *Aron* v. *Manhattan Ry. Co.*, 132 U. S. 84, 90.

See also *Electric Cable Co.* v. *Edison Co.*, 292 U. S. 69; *Cash Register* v. *Cash Indicator Company*, 156 U. S. 502, 514; *Smith* v. *Hall*, 301 U. S. 216, 233.

In the case at bar it is not a question of a new result nor an old one performed more efficiently but of a mere combining of old devices each performing its old function and working out its own effect, without producing anything novel or new as a result of the combination, which is not patentable. *Adams* v. *Bellaire*, 141 U. S. 539; *Ide* v. *Ball Engine Co.*, 149 U. S. 550. This court should not be called upon again to pass upon the application of well-known principles of patent law.

Answering Petitioner's Argument Appearing as 4, on Page 16 of its Brief.

This court has frequently decided what a true combination is. In any event, as heretofore stated that was not the point involved in the case at bar as decided by the Circuit Court of Appeals.

It has been shown in this brief that the findings of the District Court were considered by the Appellate Court. It has also been shown that the Appellate Court did not reconstruct or reorganize a prior patent in the light of the teachings of the patent in suit.

CONCLUSION.

It is respectfully submitted that the questions presented by petitioner on page 3 of its petition and brief are in fact no questions at all and are not of such nature which should be considered by this court. The Circuit Court of Appeals in its opinion dealt with the pertinent Findings of Fact of the District Court and decided them to be "clearly erroneous". The Appellate Court did not reconstruct a prior patent in the light of the teachings of the patent in suit, but defeated the patent in suit on sound principles of patent law applied to the teachings of the prior art. No new result was produced; nor did the combination of old elements co-act together to produce the old result of the prior art in a more "facile, economical and efficient manner".

The petition is a captious one, apparently being made for purposes of delay so that the grant of the patent in suit may be continued as long as possible. No reason has been shown to warrant the exercise of this court's supervisory powers, and the petition should be denied.

New York, N. Y., May 12, 1941.

Respectfully submitted,

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